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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/556,839	04/21/2000	Miriam Mawle	06181-862002	6339

7590

05/07/2002

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EXAMINER

WHITE, CARMEN D

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 05/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/556,839

Applicant(s)

MAWLE ET AL.

Examiner

Carmen D. White

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### ***Drawings***

This application has been filed with informal drawings, which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The following claims contain indefinite language that makes it difficult to ascertain the scope of the claims:

Claim 1, line 9 recites "substantially different".

Claim 20, line 2 recites "being configured to".

Claim 36, line 2 recites "substantially the same as".

Claim 24 recites the limitation "the play pattern" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5 and 7-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gabai** et al (5,752,880) in view of **Sharpe** III et al (6,012,961) or **Rifkin** et al (5,873,765).

Regarding claims 1-2, 5, 9-11, 14-15, 18, 20-28 and 32-37, Gabai teaches a game comprising a toy figure that receives information relating to the toy figure; a first game system configured to communicate with the toy figure, download information relating to the toy figure, receive input from a user, and alter stored information based on the received input and the downloaded information and a second game system that provides the same functions as the first and further capable of providing different play pattern as the first game system (Fig. 1A; col. 2, lines 9-11; col. 3, lines 26-57, which describe the sound and identification data transferred/received bi-directionally between the computer game system and the toy figure; col. 4, lines 57-60 and col. 9, lines 66-67 through col. 10, lines 1-14, which teach user interfacing. While Gabai teaches that multiple computers gaming systems can be used for communicating with multiple toy figures, the reference does not explicitly state that different play patterns are used on the various computer game systems. However it is well known in the art to have multiple gaming software stored on computer gaming systems for various games, thus it would've been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the toy in various types of games. This is merely a matter of changing the software in the gaming system. Further, Gabai teaches that information is downloaded and transferred to the toy figure from the gaming systems. However, it is silent as to the memory used for storage of this data. In analogous gaming systems

that include a toy figure controlled by a game system, Sharpe or Rifkin teach the downloading of game data into the memory of the toy figure (Sharpe- lines 1-5 of abstract; Rifkin- lines 6-11 of abstract). It would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate the memory storage taught by Sharpe or Rifkin in the toy of Gabai to allow for the storage of a greater amount of data. This is well known in the art.

Regarding claim 3, Gabai in view of Sharpe or Rifkin teaches all the limitations of the claims as discussed above. As stated above, Sharpe or Rifkin teaches the use of memory in the toy figure. However the references are silent about the memory being read only. It would have been obvious to incorporate ROM in Sharpe or Rifkin in order to prevent the toy from being reprogrammed by those unauthorized to change the gaming parameters. The use of read only memories is well known in the art.

Regarding claims 7-8, Gabai in view of Sharpe or Rifkin teaches all the limitations of the claims as discussed above. While Gabai teaches various types of information relating to the toy figure, including audio/visual toy data, Gabai is silent on the specific types of toy figure information such as past game statistics, game rules, power type, weakness type and resistance type. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include these specific types of information as a means of tailoring the figure for specific types of game play. This would merely involve altering game software depending on the type of game that the toy figure is used to play.

Regarding claims 16, 17 and 19, Gabai in view of Sharpe or Rifkin teaches all the limitations of the claims as discussed above. Gabai does not explicitly state whether or note the game system is an arcade game, race track game or a networked game. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to replace the computer with an arcade game or race track game or to incorporate the computer in an Internet game because it is well known in the art to do so. This would broaden the functionalities and locations of the game system.

Regarding claims 12 and 13, Gabai in view of Sharpe or Rifkin teaches all the limitations of the claims as discussed above. Gabai is silent on the game system being hand-held or a game board. However it is well known in the art to have hand-held and game board game systems. Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention to replace the computer game system of Gabai with a hand-held computerized device in order to make the system more compact and portable. Further it would have been obvious to a person of ordinary skill in the art at the time of the invention to replace the computer game system of Gabai with a game board in order to accommodate various game-specific software and features.

Regarding claims 29-30, Gabai in view of Sharpe or Rifkin teaches all the limitations of the claims as discussed above. Gabai further teaches the storage and use of a unique code to identify the toy figure (col. 3, lines 26-35).

Regarding claim 31, Gabai in view of Sharpe or Rifkin teaches all the limitations of the claims as discussed above. While Gabai teaches the use of a unique code to

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identify the toy figure, as discussed above, the Gabai is silent as to whether or not the code is formed into the figure and visible to the user. It is well known in the art to put serial numbers/codes on toy figures for identification. Therefore it would have been obvious to a person of ordinary skill in the art to incorporate this feature in the toy of Gabai in order to allow the user to quickly reference the toy in cases where the toy may need to be repaired or replaced.

Claims 4 and 6 rejected under 35 U.S.C. 103(a) as being unpatentable over **Gabai** et al (5,752,880) in view of **Sharpe** III et al (6,012,961) or **Rifkin** et al (5,873,765), further in view of **Kikinis** (5,746,602).

Regarding claims 4 and 6, Gabai in view of Sharpe or Rifkin teaches all the limitations of the claims as discussed above. While Gabai teaches modes of wireless communication between the game systems and the toy figures, Gabai is silent on the use of mating connectors and inductive or capacitive coupling as communications modes. In analogous gaming system, Kikinis teaches the use of a plurality of communication modes including the aforementioned modes (col. 3, lines 6-12). It is well known in the art to use these modes for communication between electronic devices. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to employ the use of these modes in Gabai in order to provide reliable, efficient modes of transferring data between the game systems and the toy figures.

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***Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Norman et al, Kubo et al, Rose, Murasaki et al and Pelekis teach interactive toys/dolls that are connected to a central gaming system.

***USPTO Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

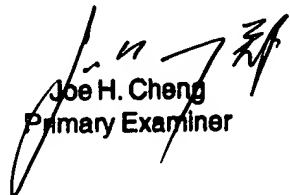
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on 703-308-2217. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7768 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.



Carmen White

*Patent Examiner, 3714*



Joe H. Cheng  
Primary Examiner